

## REMARKS

Claims 1-42 are canceled. Claims 1-38 were previously canceled in the Response to Office Action filed on August 13, 2001 and Claims 39-42 were previously canceled in the Response to Restriction Requirement filed on November 3, 2000.

Claims 43-60, 62, 65-80, and 82 are pending; claims 44, 45, 48-50, 54, 57-60, 62, 70, 71 and 76 are withdrawn and claims 43, 46, 47, 51-53, 55-56, 65-69, 72-75, 77-80, and 82 are under examination. Claims 43, 66, 80 and 82 are being amended and claims 83-94 are being added by this Amendment.

Support for the amendments to claims 43, 80, and 82 can be found, *inter alia*, on page 18, second full paragraph, to page 18, fifth full paragraph of the specification.

Claim 66 has been amended to correct an obvious typographical error.

Support for new claims 83-85 can be found, *inter alia*, on page 6, third full paragraph, page 12, third full paragraph, and page 13, third full paragraph of the specification.

Support for new claims 86-94 can be found, *inter alia*, in the paragraph bridging pages 18 and 19 of the specification.

Accordingly, no new matter is being introduced by way of this Amendment.

Claims 43, 46, 47, 51-53, 55-56, 65-69, 72-75, 77-80, and 82-94 will be pending and under examination upon entry of this Amendment.

### **Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 43, 46, 47, 51-53, 65-69, 72-75, 77-80 and 82 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite.

Claims 43, 80, 82 and their dependents are rejected on the basis that they allegedly recite "a step comprising" (i), (ii), and (iii) in part (c) of each claim.

In response, Applicant respectfully traverses the rejection. Part (c) of each of claims 43, 80, and 82 was amended by Applicant's June 10, 2011 Amendment to recite "performing the following steps in any order, and at least one time." Accordingly, rejection has been obviated and should be withdrawn.

Claims 66 and 69 and their dependents are rejected on the basis that there is insufficient antecedent basis for the recitation of "the at least one organism marker." Claims 66 and 69 ultimately depend from claims 80 and 82, respectively.

In response, Applicant respectfully traverses the rejection. Applicant's June 10, 2011 Amendment amended claims 80 and 82 to recite "at least one organism marker," thereby providing antecedent basis for the recitation of "the at least one organism marker" in claims 66 and 69. Accordingly, the rejection has been obviated and should be withdrawn.

#### **Rejection Under 35 U.S.C. § 102(a)**

Claims 43, 46, 47, 51-53, 55, 56, 65-69, 72-75, 77-80, and 82 stand rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by Stein *et al.*, 1996, J. Bacteriol. 178(3):591-599 ("Stein"). Specifically, the Examiner alleges that Stein teaches all the elements of all the claims, including subjecting an organism sample to "filtration" which "selects based on size." The Examiner further alleges that "size is a morphological marker," and that the specification and claims "do not exclude size as an organism marker." The Examiner further alleges that the fosmid transfected *E. coli* of Stein represents "a heterologous population since, for example the initial population subjected to selection either contained fosmids/plasmids or did not and also contained different fosmids/plasmids, for example."

In response, solely for the purpose of expediting prosecution and without conceding the correctness of the Examiner's position, independent claims 43, 80 and 82 have been amended to specify a selection or recovery step based on a nucleic acid marker characteristic of an organism in the initial organism sample. Amended claims 43, 80, and 82 are not anticipated by Stein because Stein fails to teach at least this feature of the claims.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Specifically, amended claims 43, 80, and 82 are based on a nucleic acid marker, not size, as an organism marker. Accordingly, to the extent that size can be considered an organism marker, it is not within the scope of the amended claims.

In addition, "selection" of *E. coli* transformed with fosmid DNA as described by Stein is not within the scope of the claims because Stein describes selecting *E. coli* based upon the presence of exogenously added fosmid DNA, not a "nucleic acid marker characteristic of an organism in the initial organism sample," *i.e.*, any "nucleic acid marker" described by Stein for selection of fosmid containing *E. coli* is characteristic of the fosmid, not of the *E. coli*.

For at least the foregoing reasons, Stein fails to anticipate the claimed invention. Applicant respectfully requests that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 102(a) in view of the claim amendments and remarks made herein.

### Conclusion

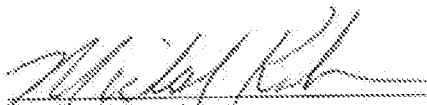
All pending claims are believed to satisfy all of the criteria for patentability and are believed to be in condition for allowance. An indication of the same is therefore kindly requested.

No fees beyond those specified in the EFS-Web Fee Calculation Screen, or accompanying Fee Transmittal, are believed to be due in connection with the submission of this paper. However, the Director is authorized to charge any additional fees that may be required, or credit any overpayment, to Deposit Account No. 010528.

Respectfully submitted,

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